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TOWNSEND and TOWNSEND and CREW LLP

By: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yaniv Gvily

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For: SNIPPET SELECTION

Confirmation No. 7515

Examiner: Adam L. Basehoar

Technology Center/Art Unit: 2178

APPELLANTS' BRIEF UNDER
37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed April 13, 2006, concurrently for the above-referenced application, Appellants submit this Brief on Appeal.

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1. REAL PARTY IN INTEREST

At the time of the filing of this appeal brief, SAP Portals, Inc. is the real party in interest for this appeal.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-28 are currently pending in the application, but stand rejected by the U.S. Patent and Trademark Office (hereinafter "Office"). Claims 1-24 were originally filed in the application on May 22, 2001. Claims 25-28 were added by Amendment filed November 24, 2004.

Claims 1-28 are believed improperly rejected and are the subject of this appeal. A copy of the claims as rejected is attached as an Appendix.

4. STATUS OF AMENDMENTS

All Amendments have been entered. No amendments have been filed subsequent to the Final Office Action mailed on February 10, 2006 (hereinafter "Final Office Action")

5. SUMMARY OF CLAIMED SUBJECT MATTER

Each of independent claims 1, 11, 18, and 24 relates to user interfaces for the selection of information. Specifically, methods for selecting hierarchical information with a computer system user interface are claimed. These independent claims each recite recognizing a selection of an element in a hierarchy, wherein the element defines a highlighted selection area on a screen (Original Application, p. 10, ll. 9-11; Fig. 7, Ref. Num. 712). The element has a hierarchical progression of ancestor elements (*Id.*, p. 10, l. 14, 32-33; Fig. 10, Ref. Num. 1008; Fig. 11). There is a distinct on-screen selection control with a plurality of control elements, each control element corresponding to an ancestor element of the hierarchy (*Id.*, p. 10, ll. 11-16; p. 11,

ll. 12-25; Fig. 7, Ref. Nums. 704, 708; Fig. 12). The selection control may be manipulated to select an ancestor element corresponding to a chosen control element (Id., p. 10, ll. 8-9, 15-16; p. 11, ll. 12-25, 30-32; Figs. 7, 8, 11, 12, Ref. Nums. 704, 708, 712, 1204, 1208).

While independent claims 1 and 24 address hierarchical information generally, independent claim 18 addresses a web page implementation, and independent claim 11 addresses receiving an HTML file and rendering an HTML page (Id., p. 7, ll. 10-17). Claim 27 describes a selection control with multiple degrees of freedom (Id., p. 12, ll. 14-32; Figs. 13a-13c).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Ground of Rejection I: Whether claims 1-16, 21, 24-25, and 27-28 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,538,673 to Maslov ("Maslov") in view of U.S. Patent No. 5,877,758 to Seybold ("Seybold").

II. Ground of Rejection II: Whether claims 17-20 and 22-23 are unpatentable under 35 U.S.C. §103(a) over Maslov in view of Seybold and in further view of W3C'S "HTML 4.0 Specification: Chapter 18: Scripts" ("W3C").

III. Ground of Rejection III: Whether claim 26 is unpatentable under 35 U.S.C. §103(a) over Maslov in view of Seybold in further view of U.S. Patent No. 5,748,512 to Vargas ("Vargas").

7. ARGUMENT

I. Ground of Rejection I: The Office Action rejected claims 1-16, 21, 24-25, and 27-28 under 35 U.S.C. §103(a) as being unpatentable over Maslov in view of Seybold.

Missing Limitations: To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143. Maslov and Seybold fail to teach or suggest an on-screen selection control containing "a plurality of control-elements ...[which] each correspond directly" to a "hierarchical progression of ancestor elements." Nor does Maslov or Seybold teach a configuration wherein "a user ... [may] choose a control-element of the plurality to thereby select the corresponding ancestor element."

The Final Office Action stated that Maslov may be relied on to teach a selection control which "allows selecting ... a hierarchically-related ... [ancestor] element by extending, contracting, or sliding the [on-screen] selection area ... i.e. user can select any size content area" (Office Action, p. 3, sec. 7). Maslov does, in fact, state that a "user can ... use the arrow keys of a computer keyboard to extend, contract, or move sideways the selection" (Maslov, col. 5, l. 50). The "selection" in Maslov refers to a highlighted screen area. The user, therefore, may "extend, contract, or move sideways" these highlighted on-screen areas.

But Maslov does not teach or suggest a distinct selection control. Nor does Maslov suggest control elements which *directly correspond* to a *hierarchical progression* of ancestor elements. Instead, the *arrow keys* allow a user to select an on-screen area (i.e., fragment). There is no direct correspondence between an arrow key and the hierarchical progression of ancestor elements for the fragment. Only once the selection is made (i.e., an on-screen area is highlighted) does the program of Maslov determine the corresponding tree node.

The Specification illustrates the differences between the Maslov reference and claim elements at issue. The following passage is instructive: "The selection control 704 lets the user select any logical unit of elements in that tree, thus in effect selecting the content of all nested elements. ... A slider 708 then enables the user to walk up and down the DOM hierarchy tree from that initial location" (Original Application, p. 14, ll. 27-31).

According to another embodiment, "[t]he ancestor elements defined on the control 704 correspond to ancestor elements in the hierarchy from HTML." (*Id.*, p. 10, ll. 15-16). A common thread is that the "control configuration ... has a scale of ancestor elements in different hierarchy levels that are selectable Once a selected element is chosen, the browser 408 (or extension 428, as the case may be) builds a list of the ancestor elements for the selected element for presentation on the slider controls" (*Id.*, p. 11, ll. 23-32). These provisions emphasize the differences between the Maslov reference and claimed elements, as the reference provides that keys may be used to *modify the highlighted screen area*, whereas the claims provide for on-screen "control-elements" which "directly correspond" to a "progression of ancestor elements."

Turning to the reference, and as noted above, Maslov teaches the *selection* of a *highlighted fragment* from a web page (Maslov, col. 8, ll. 39-49; Figs. 2 and 3). Only *after* the fragment is selected does the Maslov program "find ... a tree node that corresponds to the document fragment selected by the user" (*Id.*, col. 9, ll. 5-7). In fact, the Examiner goes on to admit that "Maslov does not teach providing a selection control that ... comprises a plurality of control elements corresponding directly to ... ancestor elements" (Final Office Action, p. 4, ll. 8-11). Yet the Examiner follows this admission with an assertion that he believes it would be obvious to modify Maslov to 1) include the distinct selection control from Seybold, and 2) configure the control elements of that selection control to correspond to ancestor elements.

But there is simply no teaching in either Maslov or Seybold to suggest the correspondence between control elements and the progression of ancestor elements. Compare the present claims, where the control elements of the selection control *directly correspond* to the *progression of ancestor elements*. This correspondence is specifically claimed, and is emphasized in the Specification, yet the Examiner deems the correspondence obvious despite no suggestion thereto in either reference. The ancestor elements are linked to the selection control in a manner not taught or suggested in Maslov or Seybold.

Turning to claim 27, a control comprising a first and a second degree of freedom is claimed. A first degree navigates ancestors and descendants of the element, and the second degree navigates among siblings of the element. There is no such control described in Maslov or Seybold, and the Examiner appears to admit as much in the Final Office Action (Final Office Action, p. 12, ll. 7-9). It is, therefore, not clear where in Maslov or Seybold the control is described. The pertinence of each reference, if not apparent, must be clearly explained. 37 CFR 1.104(c)(2). If the Examiner is relying on official notice, the Applicants respectfully traverse this official notice and hereby request an express showing of documentary proof of this proposition, as set forth in MPEP 2144.03.

Motivation to Combine: Moreover, there is no suggestion in the references to modify the teachings of Maslov to include Seybold. The requisite motivation to

modify Maslov is lacking, as is motivation for the specific combination of elements. The following excerpt is believed apt in the present case:

"In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant ... has presented claims to a new combination of elements." Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

The basic test for establishing obviousness requires that to "establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in the applicant's disclosure." MPEP § 2143.

But the Office instead relies upon the contention that it would be obvious to modify Maslov to include the distinct slider control as shown in Séybold to provide an "easy, efficient, and intuitive manner for adjustment" (Office Action, p. 4, II. 14-21). But this does not constitute proper motivation - it addresses *the benefits* of such a system, and not a suggestion to combine the teachings of the references. Unless the art itself "suggests the desirability of the combination," user benefits alone are clearly not enough. MPEP 2143.1.

While the Maslov reference concerns document tree navigation and transformation, the Seybold reference describes a "slider control [that] can be used to change the format or appearance of a timescale presented by the user interface"(Seybold, Abstract). There is simply no suggestion in Seybold that the slider control therein be used to navigate a DOM tree, or correspond to a progression of ancestor elements - the teachings instead relate to a timescale.

Independent claims 1, 11, and 24 are allowable for at least the reasons cited above. Claims 2-10, 12-17, and 25-28 each recite limitations in addition to those in the independent claims, and these dependent claims are believed allowable for at least the same reasons as given above.

II. Ground of Rejection II: Claims 17-20 and 22-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Maslov in view of Seybold and W3C.

Missing Limitations: 35 U.S.C. §103, Maslov, Seybold, W3C

The *Missing Limitations* arguments set forth in Ground of Rejection I comprise the applicable arguments reasoning that there are limitations in the claims which are attributed to Maslov or Seybold, but not found in those references. Instead of repeating the same argument again, the *Missing Limitations* arguments set forth in Ground of Rejection I are hereby incorporated as the *Missing Limitations* argument for Ground of Rejection II.

Motivation to Combine: 35 U.S.C. §103, Maslov, Seybold, W3C

The *Motivation to Combine* Arguments set forth in Ground of Rejection I comprise the applicable arguments reasoning that there is no motivation to combine Maslov with Seybold and W3C. Instead of repeating the same argument, the *Motivation to Combine* arguments set forth in Ground of Rejection I are hereby incorporated as the *Motivation to Combine* arguments for Ground of Rejection II.

Independent claim 18 is allowable for at least the reasons cited above. Claims 19-23 each recite limitations in addition to those in the independent claims, and these dependent claims are believed allowable for at least the same reasons as given above.

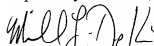
III. Ground of Rejection III: Claim 26 depends from claim 1, and stands rejected under 35 U.S.C. §103(a) as being unpatentable over Maslov in view of Seybold and in further view of Vargas. Dependent claim 26 recites limitations in addition to those in independent claim 1, and this dependent claim is believed allowable for at least the reasons as given above for claim 1.

Specifically, the *Missing Limitations* and *Motivation to Combine* arguments set forth in Ground of Rejection I comprise the applicable arguments for claim 26. Instead of repeating the same argument again, these arguments set forth in Ground of Rejection I are hereby incorporated as the arguments in support of Ground of Rejection III.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,



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9. CLAIMS APPENDIX

1. (Previously Presented) A method for selecting hierarchical information with a computer system user interface, the method comprising steps of:

recognizing selection of an element in a hierarchy, wherein the element defines a highlighted selection area on a screen;

determining a plurality of ancestor elements for the element, wherein the plurality comprise a hierarchical progression of ancestor elements;

providing a selection control displayed on the screen for the computer system user interface, wherein,

a plurality of control-elements on the selection control each correspond directly to a different ancestor element of the plurality of ancestor elements;

the selection control is configured to allow a user to choose a control-element of the plurality to thereby select the corresponding ancestor element; and

the selection control is distinct from the highlighted selection area on the screen;

recognizing manipulation of the selection control to choose the control-element; and

selecting the corresponding ancestor element in response to the second-listed recognizing step.

2. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, further comprising steps of:

associating a trigger with content for the unit; and

notifying a user when the content changes and the trigger occurs, wherein the notification comprises a message.

3. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the selecting step comprises a step of selecting all descendent elements for the selected ancestor element.

4. (Original) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the selection control allows selecting a plurality of sibling elements related to one of the element and the plurality of ancestor elements.

5. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein:
the providing step comprises a step of providing a plurality of sibling elements related to at least one of the element and the plurality of ancestor elements; and
the control allows selecting a path through the plurality of sibling elements and plurality of ancestor elements wherein crossed elements and their respective descendent elements are selected.

6. (Original) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the hierarchy is derived from an hypertext markup language (HTML) page.

7. (Original) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, further comprising a step of building a document object model from an HTML page.

8. (Original) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the providing step comprises steps of:
providing a range of ancestor elements of the element along a sliding scale; and
providing a user-manipulatable slider that indicates a selected ancestor element in the range of ancestor elements.

9. (Original) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the hierarchy represents one of:

- a software program with nesting;
- a HTML file;
- an extensible markup language (XML) document; and
- an organization chart.

10. (Original) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the second-listed recognizing step comprises steps of at least one of:

- recognizing selection of one of the plurality of ancestor elements in the hierarchy;
- and
- recognizing selection of a sibling element in the hierarchy.

11. (Previously Presented) A method for selecting hypertext markup language (HTML) information with a computer system user interface, the method comprising steps of:

- receiving an HTML file from a server wherein the HTML file has a hierarchy;
- rendering an HTML web page corresponding to the HTML file;
- recognizing selection of an element in the hierarchy, wherein the element defines a highlighted selection area on a screen and the element has a hierarchical progression of ancestor elements;
- recognizing manipulation of a selection control to choose a control-element among a plurality of control-elements on the selection control, wherein,
 - the plurality of control-elements each correspond directly to a different ancestor element of the progression of ancestor elements;

the selection control is displayed on the screen for the computer system user interface; and

the selection control is distinct from the highlighted selection area on the screen; and

selecting, in response to the second-listed recognizing step, the ancestor element corresponding to the control-element.

12. (Original) The method for selecting HTML information with the computer system user interface as recited in claim 11, further comprising a step of determining the hierarchy for the HTML file.

13. (Original) The method for selecting HTML information with the computer system user interface as recited in claim 11, wherein the rendering step comprises a step of rendering the HTML web page corresponding to the HTML file without visible modification.

14. (Previously Presented) The method for selecting HTML information with the computer system user interface as recited in claim 11, wherein the selecting step comprises selecting at least two items chosen from the element, the plurality of ancestor elements and a sibling element.

15. (Previously Presented) The method for selecting HTML information with the computer system user interface as recited in claim 11, receiving a triggering condition that triggers an alert if content of the the selected ancestor element changes to satisfy the triggering condition, wherein the alert comprises a message.

16. (Original) The method for selecting HTML information with the computer system user interface as recited in claim 11, further comprising a step of receiving a triggering condition from a user related to the element.

17. (Previously Presented) The method for selecting HTML information with the computer system user interface as recited in claim 11, further comprising steps of:

producing a processed web page related to the HTML web page, wherein the producing step comprising steps of:

deactivating active elements within the HTML web page, and

embedding a selection script into the HTML web page, wherein the selection script provides the selection control.

18. (Previously Presented) A method for allowing selection of snippets from a web page, the method comprising steps of:

producing a processed web page related to the web page, wherein the producing step comprising steps of:

deactivating active elements within the web page, and

embedding a selection script into the web page, wherein the selection script provides a selection control, which is displayed on a screen that also displays the processed web page;

recognizing selection of an element in a hierarchy that is related to the processed web page, wherein the element defines a highlighted selection area on the screen and the highlighted selection area is distinct from the selection control;

determining a plurality of ancestor elements for the element, wherein the plurality comprise a hierarchical progression of ancestor elements;

recognizing manipulation of the selection control to choose a control-element among a plurality of control-elements on the selection control, wherein the plurality of control-elements each correspond directly to a different ancestor element of the progression of ancestor elements; and

selecting the corresponding ancestor element in response to the second-listed recognizing step.

19. (Original) The method for allowing selection of snippets from the web page as recited in claim 18, further comprising steps of:

determining a plurality of probable snippets for the web page;
adding functionality to the web page to allow selection of the plurality of probable snippets; and
receiving input selecting one of the plurality of probable snippets.

20. (Original) The method for allowing selection of snippets from the web page as recited in claim 18, receiving an address for the web page by a semi-proxy.

21. (Previously Presented) The method for allowing selection of snippets from the web page as recited in claim 18, further comprising steps of:

associating a trigger with content for the selected ancestor element; and
notifying a user when the content changes and the trigger occurs, wherein the notification comprises a message.

22. (Original) The method for allowing selection of snippets from the web page as recited in claim 18, wherein the processed web page has no visual differences from the web page.

23. (Original) The method for allowing selection of snippets from the web page as recited in claim 18, wherein the determining step comprises a step of analyzing a document object model related to the processed web page.

24. (Previously Presented) A software product embodied on a computer-readable medium for selecting hierarchical information with a computer system user interface, the software product comprising code for:

recognizing selection of an element in a hierarchy, wherein the element defines a highlighted selection area on a screen;

determining a plurality of ancestor elements for the element, wherein the plurality comprise a hierarchical progression of ancestor elements;

providing a selection control displayed on the screen for the computer system user interface, wherein,

a plurality of control-elements on the selection control each correspond directly to a different ancestor element of the plurality of ancestor elements;

the selection control is configured to allow a user to choose a control-element of the plurality to thereby select the corresponding ancestor element; and

the selection control is distinct from the highlighted selection area on the screen;

recognizing manipulation of the selection control; and

selecting the corresponding ancestor element in response to the second-listed recognizing step.

25. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the control comprises a slider control movable along a sliding scale, and different increments of the sliding scale comprise different control-elements.

26. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein the control comprises two or four soft buttons.

27. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein:
the control comprises a first and a second degrees of freedom,
a first degree navigates ancestors and descendants of the element, and
the second degree navigates among siblings of the element.

28. (Previously Presented) The method for selecting hierarchical information with the computer system user interface as recited in claim 1, wherein:
the control comprises a slider control movable along a sliding scale, and
the sliding scale is demarked with characters that comprise the selected ancestor element.

10. EVIDENCE APPENDIX

None

11. RELATED PROCEEDINGS APPENDIX

None